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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,969	04/25/2006	Thomas Wegmann	P/3610-66	7580
2352	7590	08/15/2008	EXAMINER	
OSTROLENK FABER GERB & SOFFEN			PRYOR, ALTON NATHANIEL	
1180 AVENUE OF THE AMERICAS				
NEW YORK, NY 100368403			ART UNIT	PAPER NUMBER
			1616	
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			08/15/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/576,969	WEGMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ALTON N. PRYOR	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 April 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicant's arguments filed 8/13/08 have been fully considered but they are not persuasive. See discussions below. Previous rejections not addressed below have been withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an invention comprising compound Ia, i.e., 2,6-dichloro-N-[[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl]benzamide plus tolylfluanid in a ratio range of 1:5 to 1:10, does not reasonably provide enablement for the invention comprising compound Ia, i.e., 2,6-dichloro-N-[[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl]benzamide plus tolylfluanid in the broad ratio range of 0.01 to 10. The specification is not enabling for an invention comprising N-[[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl]-2-fluoro-6-nitrobenzamide (compound Ib) or N-[[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl]-2-fluoro-6-nitrobenzamide (compound Ic) plus tolylfluanid. Compounds Ib and Ic differ in chemical functionality from compound Ia. Therefore, the activity of compound Ia would not render the activity of compound Ib and Ic obvious. Small changes in chemical functionality on a chemical structure core may affect the activity of a compound. The specification is also not enabling for an invention comprising preventing or curing fungi growth. The specification does not enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

***Possession Based on Ordinary Skilled Artisan's Determination/ State of the Prior Art***

It is accepted in the art that compounds Ia, Ib, Ic and tolylfluanid are fungicides. In fact, WO 03/034824 teaches that compounds Ia, Ib and Ic are fungicides used to control (rather than prevent or cure) fungi growth and The Agricultural Handbook, 3<sup>rd</sup> edition, A0400, August 1991 teaches that tolylfluanid is a fungicide used to control (rather than prevent or cure) fungi growth. Based on these teachings, one of ordinary skill in the art would have been motivated to combine compounds Ia, Ib, or Ic with tolylfluanid expecting that the resulting combinations would show fungicidal activity.

An analysis based upon the Wands factors is set forth below.

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. In *Genentech Inc. v. Novo Nordisk* 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997); *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)., See also *Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed. Cir. 1991); *In re Fisher* 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Further, in *In re Wands* 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) the court stated:

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman* (230 USPQ 546, 547 (Bd Pat App Int 1986)). They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art and (8) the breadth of the claims.

***Breadth of Claims***

Applicants' claims are to combinations of compounds Ia, Ib, or Ic with tolylfluanid in a ratio of 0.010 to 10.

***Nature of the invention/State of the Prior Art***

Claims 11-20 of the instant application which claim an invention comprising compounds Ia, Ib, or Ic with tolylfluanid in a ratio of 0.010 to 10 is representative of the nature of Applicants' invention. It is accepted in the art that compounds Ia, Ib, Ic and tolylfluanid are fungicides. In fact, WO 03/034824 teaches that compounds Ia, Ib and Ic are fungicides used to control fungi growth and The agricultural Handbook, 3<sup>rd</sup> edition, A0400, August 1991 teaches that tolylfluanid is a fungicide used to control fungi growth. Based on these teachings, one of ordinary skill in the art would have been motivated to combine compounds Ia, Ib, or Ic with tolylfluanid expecting that the resulting combinations would show fungicidal activity.

***Level of One of Ordinary Skill & Predictability/Unpredictability in the Art***

The level of a person of ordinary skill in the art is high, with ordinary artisans having advanced scientific degrees (M.S., Ph.D., or combinations thereof). There is a general lack of predictability in the fungicidal art. The art is especially unpredictable with regards to the existence and formation of compositions yielding better than additive activity for the chemical combinations set forth by the claims.

***Guidance/Working Examples***

Applicants provide examples depicting better than additive activity for an invention comprising compound Ia, i.e., 2,6-dichloro-N-[3-chloro-(trifluoromethyl)-2-

pyrindyl]methyl}benzamide plus tolylfluanid in a ratio range of 1:5 to 1:10 on pages 12-13 of the specification.

However, Applicants' specification does not provide better than additive activity for an invention comprising compound Ia, i.e., 2,6-dichloro-N-{{3-chloro-(trifluoromethyl)-2-pyrindyl]methyl}benzamide plus tolylfluanid in the broad ratio range of 0.01 to 10. The Applicants' specification does not provide better than unexpected results for an invention comprising N-{{3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-nitrobenzamide (compound Ib) or N-{{3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-nitrobenzamide (compound Ic) plus tolylfluanid. The Applicants' specification also does not provide examples of how the claimed combination of ingredients would prevent or cure fungi growth.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer et al (WO 03/034824; 5/1/03) and The Agrochemicals Handbook, 3rd edition, A0400, August 1991. Mercer et al. teach a fungicidal composition comprising a compound of instant formula I wherein the compound of formula I can be Ia, Ib or Ic. See abstract, pages 5,6,10. Mercer teaches that the composition can comprise phosphorous acid derivatives such as fosetyl - Al which is aluminum ethyl hydrogen

phosphonate as well as carriers. See page 14 line 26 and page 15 lines 9-15. Mercer teaches a method of applying the composition onto seed and vine plants in order to control fungi growth. See page 16 lines 7-8 and page 24 lines 23-28. Mercer does not teach the composition / method comprising tolylfluanid. However, The Agrochemicals Handbook discloses that tolylfluanid is a fungicide. It would have been obvious to modify the composition / method of Mercer to include the tolylfluanid taught by The Agrochemical Handbook. One would have been motivated to do this since Mercer is open to the inclusion of other fungicides. See Mercer page 14 lines 1-2. With respect to the amounts and ratios of ingredients, one having ordinary skill would have determined the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to develop an invention that would have been most effective in controlling fungi. It is possible that the optimum amounts / ratios of ingredients determined for the instant invention could have fallen within the instant ratios and amounts. The specification provides unexpected (synergistic) results for the composition / method comprising a compound of formula Ia, i.e, 2,6-dichloro-N-[3-chloro-(trifluoromethyl)-2-pyridyl]methyl}benzamide and tolylfluanid in a ratio range from 1:5 to 1:10. However, the claims are not commensurate in scope with the unexpected results.

**New Rejection**

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/884,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions make claim to an invention comprising compounds Ia, Ib or Ic plus tolylfluanid. The claims of instant application versus those of USAN '154 differ in scope. The instant independent claim 20 comprises compound of formula Ia, Ib or Ic plus tolylfluanid, whereas '154 independent claim 1 comprise compound Ia, Ib or Ic but does not recite tolylfluanid. However, claim 12 of '154 recite, "A composition according to claim 1 further comprising a fungicidal compound (c)". Note, the description of compound (c) in the specification of '154 on pages 4-5 includes tolylfluanid. For this reason '154 makes the claims of the instant application obvious in that one would have been motivated to add tolylfluanid to compound Ia, Ib or Ic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616